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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/430,198	10/29/1999	DAVID ZAHNISER	CYM-034	6914
23639	7590	02/01/2005	EXAMINER	
BINGHAM, MCCUTCHEN LLP THREE EMBARCADERO, SUITE 1800 SAN FRANCISCO, CA 94111-4067			KIM, CHONG R	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/430,198

Applicant(s)

ZAHNISER ET AL.

Examiner

Charles Kim

Art Unit

2623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 112 second paragraph rejection.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-14,20,21,23-25.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


Jon Chang
Primary Examiner

Continuation of 5. does NOT place the application in condition for allowance because: Applicants argue (page 7) that "the Examiner's reading of Gibbs that the mere relocation of an area of interest at a position that approximates the original location of the area of interest constitutes a verification of that area of interest is an error...merely because a machine is designed to relocate an area of interest at its originally determined position, as with all automated microscopes, does not mean that the area of interest is verified." The Examiner responds by pointing out that the term "verify" is defined by the Webster's dictionary as "to determine or test the truth or accuracy". In this case, Gibbs clearly determines the truth or accuracy of the location of the area of interest. For example, Gibbs states that "the exact position of the detected microscopic object in the microscope's visual field upon the pressing of key GO depends upon the exact positioning of the reference mark 72 in the visual field at the beginning of the first inspection (locating the datum) and at the beginning of the reinspection (relocating the datum)" [col. 10, lines 6-11]. Gibbs also explains that the step of relocating the datum results in a position that is approximate to the position determined originally during the initial location of the datum (col. 9, lines 60-65). As noted in the previous office action (page 5), the approximate position determined during the relocation process results in a dimensional error. Accordingly, the dimensional error will determine the accuracy of the location of the area of interest. In other words, the accuracy of the location of the area of interest is based on a dimensional error in locating the datum relative to relocating the datum. Therefore, Gibbs appears to disclose a verification of the location of the area of interest.

Applicants further argue (page 9) that, "Applicant can only conclude that the Examiner improperly used the disclosure of the present application for the teaching that it would have been obvious to modify the Gibbs device to verify an area of location based on the dimensional error between the location and relocation of a datum mark on the slide." In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, Gibbs discloses a dimensional error in locating the datum relative to relocating the datum (as noted above). Gibbs also discloses that the verification (accuracy) of the location of the area of interest is based on the dimensional error (also note above). Therefore, it appears that the knowledge taken into account was within the level of ordinary skill at the time of the claimed invention and did not include knowledge gleaned only from the applicant's disclosure.

Applicants further argue (page 10) that "the Examiner failed to explain why one of ordinary skill in the art, after reading Ortyn, would modify the Gibbs device to verify the area of interest based on the spatial offset value between the location and relocation of a datum mark on an actual biological slide." The Examiner responds by pointing out that Ortyn is not relied upon to teach the step of locating and relocating the datum on the biological slide. Gibbs teaches this feature in col. 9, lines 12-66. Note that Ortyn is relied upon to teach the step of determining the spatial offset value of the relocated mark relative to the initial located mark.